

17231 U.S. PTO  
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17513 U.S. PTO  
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December 11, 2003

**VIA EXPRESS MAIL NO. EL935483847US**

Mail Stop: Reissue  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: Patentee: Stephen M. Zappala  
Patent No.: 6,329,398  
Filed: March 30, 2001  
Issue Date: December 11, 2001  
For: PREEMPTIVE ANALGESIC AGENT AND METHODS OF USE  
Docket No.: 16865-00012

Dear Sir/Madam:

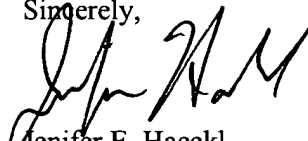
Enclosed for filing is a Reissue Application, including a copy of U.S. Pat. No. 6,329,398 B1; an attached Preliminary Amendment, including 33 claims (5 independent and 28 dependent); a check in the amount of \$588.00 for the filing fee; a Petition for Acceptance of an Unintentionally Delayed Claim for Priority under 35 U.S.C. § 120, including a check in the amount of \$1,330.00; an Information Disclosure Statement and Form PTO-1449, including cite prior art; and a copy of the Decision Dismissing Petition, dated November 25, 2003.

If any payment is found to be insufficient or if any overpayment is found, please charge any deficiency or credit any overpayment to our deposit account number 50-1582. A copy of this letter is enclosed for use by the Finance Branch in the event that it becomes necessary to make any charge or credit to the deposit account.

If for any reason the enclosed communication is found to be incomplete, or if at any time it appears that a telephone conference with counsel would be helpful, please telephone the undersigned at (508) 898-1501.

Kindly acknowledge receipt of the foregoing by returning the enclosed self-addressed postcard.

Sincerely,

  
Jennifer E. Haeckl

JEH/slk  
Enclosures

MIRICK O'CONNELL

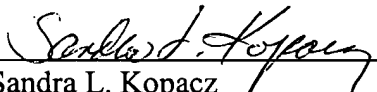
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CERTIFICATE OF EXPRESS MAILING

I hereby certify that the attached REISSUE APPLICATION, including a Preliminary Amendment, a Petition for Acceptance of an Unintentionally Delayed Claim for Priority, and Information Disclosure Statement, including Form PTO-1449 and cited prior art, is being deposited with the United States Postal Service, Express Mail Certificate No. EL935483847US, on this 11th day of December 2003, in an envelope addressed to Mail Stop Reissue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Sandra L. Kopacz



UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 4

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**OFFICE OF PETITIONS**

In re Patent No. 6,329,398  
Issue Date: December 11, 2001  
Application No. 09/821,922  
Filed: March 30, 2001  
Attorney Docket No. 16865-00012

:DECISION DISMISSING PETITION  
:UNDER 37 CFR 1.78(a)(3) AND 37  
:CFR 1.78(a)(6) AND REQUEST  
:FOR CERTIFICATE OF  
:CORRECTION

This is a decision on the petition filed October 1, 2003, which is being treated as a petition under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) seeking to add a claim for priority on the front page of the Letters Patent by way of a Certificate of Correction to prior-filed nonprovisional Application No. 09/656,050, filed September 6, 2000, and to provisional Application No. 60/152,718, filed September 7, 1999.

The petition is dismissed.

Any request for reconsideration of this decision should be filed within two months from the mail date of this decision. *Note* 37 CFR 1.181(f). Extensions of time are not available under 37 CFR 1.136(a) or (b).

A review of the file record fails to disclose that a claim for the benefit of priority to prior-filed nonprovisional Application No. 09/656,050 and provisional Application No. 60/152,718 was made within the time period set forth in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the review further indicates the amendment proffered with the petition fails to include a proper reference to the prior-filed applications as required by 37 CFR 1.78(a)(2)(I) and 1.78(a)(2)(iii) and 37 CFR 1.78(a)(5)(I) and 1.78(a)(5)(iii).

**DISCUSSION OF CLAIM FOR BENEFIT OF PRIORITY TO NONPROVISIONAL APPLICATION NO. 09/656,050 UNDER 35 U.S.C. § 120**

The instant application was filed April 24, 2002. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3) is the

appropriate avenue of relief to accept, as here, a late claim for the benefit of priority of a prior-filed nonprovisional application

Where priority is based upon 35 U.S.C. § 120 to a national application, the following conditions must be satisfied in the instant patent file:

- (A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;
- (B) the prior copending application to be added via the Certificate of Correction must be identified elsewhere (other than the first sentence of the specification following the title or in an application data sheet) in the application papers;
- (C) it must be clear from the record of the patent and the parent application(s) that priority is appropriate; and
- (D) a grantable petition to accept an unintentionally delayed claim for the prior application must be filed, including a surcharge as set forth in 37 CFR 1.17(t), as required by 37 CFR 1.78(a)(3).

If all the above-stated conditions are satisfied, a Certificate of Correction under 35 U.S.C. 255 can be used to amend the patent to make reference to a prior copending application for benefit claims under 35 U.S.C. § 120. However, if any of the above-stated conditions is not satisfied, the filing of a reissue application may be appropriate to pursue the desired correction of the patent for benefit claims under 35 U.S.C. § 120.<sup>1</sup>

A review of the application file fails to disclose compliance with item (B) above in that nowhere is nonprovisional Application No. 09/656,050 identified in the application file. In view thereof, it would not be appropriate to grant the petition under 37 CFR 1.78(a)(3) to accept a late claim to priority to nonprovisional Application No. 09/656,050 and to issue a Certificate of Correction to add this claim for priority on the front page of the Letters patent.

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<sup>1</sup> Note MPEP 1481.

**DISCUSSION OF CLAIM FOR BENEFIT OF PRIORITY OF PROVISIONAL**  
**APPLICATION NO. No. 60/152,718 UNDER 35 U.S.C. § 119(e)**

The instant application was filed April 24, 2002. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(6) is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed provisional application.

Where priority is based upon 35 U.S.C. § 119(e) to a provisional application, MPEP § 1481 states:

Under no circumstances can a Certificate of Correction be employed to correct an applicant's mistake by adding or correcting a priority claim under 35 U.S.C. 119(e) for an application filed on or after November 29, 2000.

Section 4503 of the American Inventor's Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section during the pendency of the application. (emphasis added)

35 U.S.C. 119(e)(1), as amended by the AIPA, clearly prohibits the addition or correction of priority claims under 35 U.S.C. 119(e) when the application is not pending, e.g., as here, an issued patent. Therefore, a Certificate of Correction is no longer a valid mechanism for adding or correcting a priority claim under 35 U.S.C. 119(e) after a patent has been granted on an application filed on or after November 29, 2000.

Under certain conditions as specified below, however, a Certificate of Correction can still be used, with respect to 35 U.S.C. 120 priority, to correct:

- (A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2); or
- (B) an incorrect reference to a prior copending application pursuant to 37 CFR 1.78(a)(2).

Since a Certificate of Correction cannot be employed to correct applicant's mistake in adding s claim for priority under 35 U.S.C. § 119(e) in an application filed on or after November 29, 2000, the petition under 37 CFR 1.78(a)(6) and issuance of a Certificate of Correction cannot be granted.

However, as noted above, petitioner may seek relief by way of the filing of a reissue application (See MPEP § 1401 - § 1460) to pursue the desired correction of the patent to include a claim for benefit of the prior nonprovisional application under 35 U.S.C. § 120. Such would also entail a further petition and fee under 37 CFR 1.78 directed to and captioned for the reissue application. See MPEP 1481. Furthermore, while, as noted above, petitioner is statutorily barred from seeking benefit under 35 U.S.C. 119(e) of the prior provisional application--via reissue or otherwise-- petitioner is **not** so barred from seeking benefit under 35 U.S.C. 120 of the prior provisional application. Note, however, that if petitioner should seek to claim § 120 benefit of the provisional application, this would affect (shorten) the term of the reissued patent, in addition to the term shortening effect of the § 120 claim for benefit of the prior nonprovisional application

The petition fee is due to the USPTO upon the filing of the petition, and furthermore, for consideration of the petition regardless of the decision, and will not be refunded. *See Ex parte VENTURA CITRUS ASSOCIATION*, 71 USPQ 103, 104 (Comm'r Pat. 1946).

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

**Effective December 1, 2003, the Office of Petitions can no longer receive hand-carried correspondence, or facsimile transmissions of correspondence. The centralized location for hand-carried correspondence is the existing Customer Window located at:**

2011 South Clark Place  
Crystal Plaza 2 Lobby  
Room 1B03  
Arlington, VA 22202

The centralized facsimile number is **(703) 872-9306**.

Any questions concerning this matter may be directed to Frances Hicks at (703) 305-8680.

A handwritten signature in cursive script, appearing to read "Brian Hearn".

Brian Hearn  
Senior Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy